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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT PAPER NUMBER

2145

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/918,312	Applicant(s) STERN ET AL.	
	Examiner Jeffrey R. Swearingen	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-17 and 19-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-17 and 19-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20060122</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/21/2005 has been entered.

Response to Arguments

2. Applicant's arguments filed 12/21/2005 have been fully considered but they are not persuasive.

3. Applicant failed to provide an embodiment of the invention that is statutory in nature. A "test email message" that is used to "verify" a "potential email address", regardless of whether it is a "business email address", is spam. Applicant admitted the useful nature of the invention in targeted advertising campaigns toward individuals on page 6 of the specification, lines 11-12.

4. Applicant argued Henrick and Miller failed to teach deducing or interpolating potential email addresses of a person named in a database whose email information is missing. Applicant argued Henrick and Miller failed to disclose verifying the potential email addresses by sending test email messages using the potential email addresses to an email server to determine a response of the email server to the test email messages. This is generating and sending an email message.

5. Applicant argued Knight and Feridun failed to disclose an integrator for combining two records of potentially a same person into one record if the person's name...and one of organization name and title is the same in the two records...and a post-processor...for...interpolating missing information. Knight taught the combining of information as did Feridun.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-11, 13-17, and 19-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-11, 13-17, and 19-23 are directed to an invention that sends unsolicited email to addresses it extrapolates from not readily available personal information that is extracted from websites via software agents. This device is non-statutory subject matter because it is in violation of the CAN-SPAM Act of 2003 (Controlling the Assault of Non-Solicited Pornography and Marketing Act) as enacted by Congress. Applicant is advised that the Federal Trade Commission is authorized to enforce the CAN-SPAM act, as is the Department of Justice. According to the requirements given by the FTC, CAN-SPAM covers "email whose primary purpose is advertising or promoting a commercial product or service, including content on a Web site". Claims 1-11, 13-17, and 19-23 refer to business e-mail addresses and testing said business e-mail addresses. This device can be embodied as a device to search for information on individuals and send them non-solicited pornography and marketing electronic messages. The FTC further states that additional fines are provided for commercial emailers who "'harvest' email addresses from Web sites or Web services that have published a notice prohibiting the transfer of email addresses for the purpose of sending email" and "generate email addresses using a 'dictionary attack' – combining names, letters, or numbers into multiple permutations". This is analogous to the claim language "automatically generating e-mail address of a subject person named in the database but for whom e-mail address information is missing from the database", "obtaining a working e-mail address to the respective organization the working e-mail address not being the e-mail address of the subject person; deducing from the working e-mail address, format of e-mail addresses to the respective organization; using the deduced information, constructing potential e-mail addresses for the subject person; and verifying each constructed potential e-mail address by testing each, such that at least one verified constructed potential e-mail address provides a business e-mail address of the subject person", for example.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-11, 13-17, and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cranor et al. ("Spam!". Communications of the ACM, August 1998. Volume 4, Issue 8. pp. 74-83).

10. In regard to claims 1-11, 13-17, and 19-23, Cranor disclosed that spamming was performed by harvesting information such as email addresses from the World Wide Web. Cranor failed to disclose a method of doing this, but disclosed that it was taking place prior to the publication of the article in 1998. Therefore methods of creating spam by harvesting information from the World Wide Web were in existence. It would have been obvious to one of ordinary skill in the art to create the invention as described in claims 1-23 since warnings and methods were in existence to prevent the effects of the claimed invention in 1998.

11. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick et al. (U.S. Patent No. 6,377,936) in view of Miller (Online Search Secrets, 173-179).

12. Regarding claim 1, Henrick discloses providing a database storing information regarding people, the database including for each person at least name of the person and the name of respective employer for which the person is currently employed [Henrick discloses a customer mailing list. See Henrick, column 3, lines 53-54.]; and using digital processor means couple to the database, automatically constructing and verifying potential e-mail address of a subject person named in the database, the e-mail address being with respect to a respective organization named in the database for the subject person [Henrick discloses generating an e-mail message. Constructing and verifying an e-mail address is part of generating an e-mail message. See Henrick, column 3, line 54]. Henrick fails to disclose what to do if email address information is missing from the database. However, Miller discloses well known

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techniques for finding email address information on the web. Therefore it would be obvious to combine the tactics of Miller with the Henrick invention in order to allow more persons to be solicited by email, thus increasing revenue for the solicitor, as taught in the Henrick patent [Henrick, column 1, lines 10-36 referring to prior art and internet marketing].

13. Regarding claim 6, the limitations of this claim are substantially the same as those in claim 1. Therefore the same rationale for rejecting claim 1 is used to reject claim 6.

14. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick in view of Miller in further view of Mills (Australian Patent Abstract No. AU-A-53031/98).

15. Regarding claim 4, Henrick in view of Miller is applied as in claim 1. Henrick in view of Miller fails to disclose *using crawler means, automatically extracting information regarding people and / or organizations from sites of a global computer network and storing the extracted information in the database, such that the database is formed by automated means.*

16. However, Mills discloses *using crawler means, automatically extracting information regarding people and / or organizations from sites of a global computer network and storing the extracted information in the database, such that the database is formed by automated means.* [See Mills, page 8, lines 38-49].

17. It would have been obvious to one of ordinary skill in the networking art at the time of the invention to combine the teachings of Mills with the teachings of Henrick in view of Miller for the purpose of improving the method of building a searchable database of contact information. [See Mills, page 6, lines 25-30]. Henrick provides motivation for the combination by stating that data mining is used to obtain information about network users. [See Henrick, column 5, lines 19-23] By this rationale claim 4 is rejected.

18. Regarding claim 9, the limitations of this claim are substantially the same as those in claim 4. Therefore the same rationale for rejecting claim 4 is used to reject claim 9.

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19. Claims 5 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick in view of Miller in view of Mills as applied to claim 4 and in view of Barroux (U.S. Patent No. 5,923,850).

20. Regarding claim 5, Henrick in view of Miller in view of Mills are applied as in claim 4. Henrick in view of Miller in view of Mills fail to disclose *employing a multiplicity of crawlers under control of a distributor*.

21. However, Barroux discloses *employing a multiplicity of crawlers under control of a distributor*.

[Barroux discloses an administrative database and a task scheduler that schedules discovery tasks to be executed on the network. Examiner considers discovery tasks to include crawlers. Examiner considers task scheduler to be a distributor. See Barroux, column 3, lines 64-67. See Barroux, column 3, lines 41-52. See Barroux, column 4, lines 54-60.]

22. It would have been obvious to one of ordinary skill in the networking art at the time of the invention to combine the teachings of Barroux with the teachings of Henrick in view of Miller in view of Mills for the purpose of tracking changes over time in information collected by network agents. [See Barroux, column 1, lines 50-56]. Henrick provides motivation for the combination by stating that data mining is used to obtain information about network users. [See Henrick, column 5, lines 19-23] Mills further provides motivation for the combination by stating that indexes [databases] are often created by use of web crawlers and that many relevant pages are missed. [See Mills, page 2, line 35 – page 3, line 19].

23. Regarding claim 10, the limitations of this claim are substantially the same as those in claim 5. Therefore the same rationale for rejecting claim 5 is used to reject claim 10.

24. Claims 2-3 and 7-8 rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick in view of Miller in view of Biliris et al. (U.S. Pub. No. 2001/0009017, hereafter referred to as Biliris.)

25. Regarding claim 2, Henrick in view of Miller is applied as in claim 1. Henrick in view of Miller fails to disclose *obtaining a working e-mail address to the respective organization, the working e-mail address not being the e-mail address of the subject person; deducing from the working e-mail address, format of e-mail addresses to the respective organization; using the deduced information, constructing potential e-*

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mail addresses for the subject person; and verifying each constructed potential e-mail address by testing each, such that at least one verified constructed potential e-mail address provides a business e-mail address of the subject person.

26. However, Biliris discloses receiving a message from a sender system with a declarative address *[obtaining a working e-mail address to the respective organization, the working e-mail address not being the e-mail address of the subject person]* and resolving the declarative address into messaging addresses by use of a database query on stored information *[deducing from the working e-mail address, format of e-mail addresses to the respective organization and using the deduced information, constructing potential e-mail addresses for the subject person]*. Biliris then transmits the messaging address(es) to the messaging server, which transmits the message to the addressed recipients *[verifying each constructed potential e-mail address by testing each, such that at least one verified constructed potential e-mail address provides a business e-mail address of the subject person]*. [See Biliris, page 1, paragraphs 0009-0011. See Biliris, page 2, paragraph 0024.]

27. It would have been obvious to one of ordinary skill in the networking art at the time of the invention to combine the teachings of Henrick in view of Miller and Biliris, for the purpose of sending messages to recipients without an explicitly enumerated mailing list. [See Biliris, page 1, paragraph 0009.] Henrick gives motivation for the combination of teachings by stating that users who might be interested in receiving information are reluctant to provide information to businesses. [See Henrick, column 1, lines 23-27.]

28. Regarding claim 3, Henrick in view of Miller in view of Biliris are applied as in claim 2. Biliris further discloses using logical combinations of filtered directory information and mailing lists to specify a list of e-mail recipients *[using predefined common email address formats, see Biliris, page 3, paragraph 0033.]*

29. Regarding claim 7, the limitations of this claim are substantially the same as those in claim 2. Therefore the same rationale for rejecting claim 2 is used to reject claim 7.

30. Regarding claim 8, the limitations of this claim are substantially the same as those in claim 3. Therefore the same rationale for rejecting claim 3 is used to reject claim 8.

31. Claims 11, 13, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knight (U.S. Patent No. 6,493,703) in view of Feridun et al. (U.S. Patent No. 6,336,139).

32. Regarding claim 11, Knight discloses a computer automated system for mining from a global computer network information on people and organizations comprising: a plurality of automated crawlers for traversing sites of a global computer network and retrieving pages that contain information of interest; a distributor coupled to the crawlers for controlling crawler processing; an extractor responsive to the crawler retrieved pages and extracting information about people and organizations therefrom; the extracted information being stored in a database; an integrator coupled to the database for resolving duplicate information and combining related information in the database; and a post-processor coupled to the database for analyzing contents of the database and generating missing information therefrom.

[Knight discloses searching a bulletin board system with software robots (plurality of automatic crawlers, column 5, lines 45-49), extracting information (column 5, lines 6-10), storing the information in a database (column 6, lines 40-59), and creates classifications of messages in logical groupings based on filters (combining related information and analyzing contents of the database and generating missing information, column 10, lines 1-53). Knight fails to disclose combining database records of information.

33. However, Feridun discloses aggregating data collected by a network agent [combining database records collected by a crawler, see Feridun, column 12, lines 37-40].

34. It would have been obvious to one of ordinary skill in the networking art at the time of the invention to combine the teachings of Knight and Feridun for the purpose of detecting status changes in monitored objects (a person, see Feridun, column 2, lines 1-3.). Knight gives motivation for the combination by stating that not distinguishing between subject areas (changes in a person) results in frustration to the user. [See Knight, column 9, lines 45-54.]

35. Regarding claim 17, the limitations of this claim are substantially the same as those of claim 11. Therefore the rationale used to reject claim 11 is used to reject claim 17.

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36. Regarding claim 13, Knight and Feridun are applied as in claim 11. Knight further discloses a prioritization scheme utilizing frequency of occurrence of a subject category (statistical rarity of title and person's name, see Knight, column 6, line 60 – column 7, line 6).

37. Regarding claim 19, the limitations of this claim are substantially the same as those in claim 11. Feridun deals with aggregating data between duplicate records. The name and organization name and title all fall into the general category of data in records.

38. Regarding claim 20, the limitations of this claim are substantially the same as those in claim 13. Therefore the rationale used to reject claim 13 is used to reject claim 20.

39. Claims 14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knight in view of Henrick.

40. Regarding claim 14, Knight is applied as in claim 11. Knight fails to disclose generating an e-mail address.

41. However, Henrick discloses generating an e-mail message. Examiner considers generating an e-mail address to be part of generating an e-mail message. See Henrick, column 3, line 54.

42. It would be obvious to one of ordinary skill in the networking art at the time of the invention to combine the teachings of Knight and Henrick for the purpose of sending e-mail by use of data mining. [See Henrick, column 1, lines 39-55.] Knight gives motivation for the combination by stating that information is gathered that is of interest to users, and that the gathered information can be transmitted to a user in the form of an electronic message. [See Knight, column 5, lines 45-67.]

43. Regarding claim 21, the limitations of this claim are substantially the same as those in claim 14. Therefore the rationale for rejecting claim 14 is used to reject claim 21.

44. Claims 15-16, 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knight, Henrick in view of Biliris.

45. Regarding claim 15, Knight and Henrick are applied as in claim 14. Knight and Henrick fail to disclose *obtaining a working e-mail address to the respective organization, the working e-mail address*

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not being the e-mail address of the subject person; deducing from the working e-mail address, format of e-mail addresses to the respective organization; using the deduced information, constructing potential e-mail addresses for the subject person; and verifying each constructed potential e-mail address by testing each, such that at least one verified constructed potential e-mail address provides a business e-mail address of the subject person.

46. However, Biliris discloses receiving a message from a sender system with a declarative address *[obtaining a working e-mail address to the respective organization, the working e-mail address not being the e-mail address of the subject person]* and resolving the declarative address into messaging addresses by use of a database query on stored information *[deducing from the working e-mail address, format of e-mail addresses to the respective organization and using the deduced information, constructing potential e-mail addresses for the subject person]*. Biliris then transmits the messaging address(es) to the messaging server, which transmits the message to the addressed recipients *[verifying each constructed potential e-mail address by testing each, such that at least one verified constructed potential e-mail address provides a business e-mail address of the subject person]*. [See Biliris, page 1, paragraphs 0009-0011. See Biliris, page 2, paragraph 0024.]

47. It would have been obvious to one of ordinary skill in the networking art at the time of the invention to combine the teachings of Knight, Henrick and Biliris, for the purpose of sending messages to recipients without an explicitly enumerated mailing list. [See Biliris, page 1, paragraph 0009.] Henrick gives motivation for the combination of teachings by stating that users who might be interested in receiving information are reluctant to provide information to businesses. [See Henrick, column 1, lines 23-27.]

48. Regarding claim 16, Knight, Henrick in view of Miller and Biliris are applied as in claim 2. Biliris further discloses using logical combinations of filtered directory information and mailing lists to specify a list of e-mail recipients *[using predefined common email address formats, see Biliris, page 3, paragraph 0033.]*

49. Regarding claim 22, the limitations of this claim are substantially the same as the limitations of claim 15. Therefore the rationale used to reject claim 15 is used to reject claim 22.

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50. Regarding claim 23, the limitations of this claim are substantially the same as the limitations of claim 16. Therefore the rationale used to reject claim 16 is used to reject claim 23.

Conclusion

51. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

52. H.R. 3162, The "Uniting and Strengthening America by Providing Appropriate Tools Required to Intercept and Obstruct Terrorism (USA PATRIOT ACT) Act of 2001, enacted by the 107th Congress of the United States of America. See Titles II and VIII-X pertaining to electronic surveillance, cyberterrorism, cybersecurity forensics, computer trespasser communications, and electronic communications.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jason Cardone
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